UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,502	08/25/2000	Mark E. Redding	230074.0230	5521

7590 10/07/2004

Ted R Rittmaster Esq
Foley & Lardner
Suite 3500
2029 Century Park East
Los Angeles, CA 90067-3021

EXAMINER	
KANG, PAUL H	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/648,502	REDDING ET AL.	
	Examiner	Art Unit	
	Paul H Kang	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., US Pat. No. 5,390,297 in view of Coley et al., US Pat. No. 5,790,664.

2. As to claim 1, Barber teaches the invention substantially as claimed. Barber teaches a system and method for managing licenses for protected software on a communication network, the system (Barber, col. 2, lines 3-54) comprising:

at least one client computer capable of being coupled to the communication network for requesting an authorization to use the protected software and for storing a commuter authorization lifetime representing a time period for which the commuter authorization is valid (Barber, col. 2, lines 3-54 and col. 5, lines 31-67 and col. 6, line 1 – col. 7, line 64); and

at least one license server coupled to the communication network, each license server programmed for managing a distribution of allocations to use the protected software and at least one license server programmed for granting an authorization in response to a request for an authorization (Barber, col. 2, lines 3-54 and col. 5, lines 31-67 and col. 6, line 1 – col. 7, line 64).

However, Barber does not explicitly teach said authorization is a commuter authorization, enabling use of software while coupled or decoupled from the network. In the same field of endeavor, Coley teaches a software licensing system wherein the at least one client computer is

configured with the protected software, the protected software being independent of the at least one license server, and wherein after a commuter authorization is communicated from a granting license server to a requesting client computer, the requesting client computer may use the protected software while coupled to or decoupled from the communication network until the commuter authorization lifetime expires, the requesting client computer utilizing the commuter authorization independently of the at least one license server (Coley, col. 4, line 1 – col. 5, line 30; col. 8, line 54 – col. 9, line 61 and col. 22, lines 5-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of software while coupled or decoupled from the network, as taught by Coley, into the system of Barber for the purpose of enhancing flexibility and convenience of software use.

3. As to claim 3, Barber-Coley teaches the system wherein the at least one license server further programmed for granting a commuter authorization to the requesting client computer and decrementing a count of available allocations only if there is an available allocation in the at least one license server (Barber, col. 2, lines 3-54 and col. 5, lines 31-67).

4. The method steps of claim 11 are a combination of the apparatus of claims 1 and 3, and have similar limitations except in method steps; therefore, claim 11 is rejected under the same rationale.

5. As to claims 2 and 12, Barber-Coley teach a system and method comprising while the requesting client computer maintains a valid commuter authorization, the requesting client computer may open the protected software multiple times, including simultaneous instantiations of the protected software (Barber, col. 2, lines 3-54 and col. 5, lines 31-67 and col. 6, line 1 – col. 7, line 64; and Coley, col. 4, line 1 – col. 5, line 30 and col. 8, line 54 – col. 9, line 61).

6. As to claims 4 and 13, Barber-Coley teach a system and method wherein the requesting client computer further including memory for storing commuter authorization information including the commuter authorization lifetime and a check-in value received from the granting license server when the granting license server grants the commuter authorization to the requesting client computer; and the granting license server further including memory for storing commuter authorization information including the commuter authorization lifetime and a check-in value when the granting license server grants the commuter authorization to the requesting client computer (Barber, col. 2, lines 3-54; col. 5, lines 31-67; col. 6, line 1 – col. 7, line 64; and col. 15, lines 10 – 55).

7. As to claims 5 and 14, Barber-Coley teaches the system and method wherein the requesting client computer programmed for returning the commuter authorization by setting its check-in value to a returned state and communicating a check-in message to the granting license server; and the granting license server further programmed for setting its check-in value to the returned state and incrementing its count of available allocations upon receipt of the check-in

message (Barber, col. 15, lines10-55).

8. As to claims 6 and 15, Barber-Coley teaches the system and method wherein if the commuter authorization is not returned prior to an expiration of the commuter authorization lifetime, at the expiration of the commuter authorization lifetime, the requesting client computer is further programmed for setting its check-in value to a returned state; and the granting license server is further programmed for setting its check-in value to the returned state and incrementing its count of available allocations (Barber, col. 2, lines 3-54; col. 5, lines 31-67; col. 6, line 1 – col. 7, line 64; and col. 15, lines 10 – 55).

9. As to claims 7 and 16, Barber-Coley teach a system and method wherein the requesting client computer programmed for enabling a user to select the computer authorization lifetime (Barber, col. 2, lines 3-54; col. 5, lines 31-67; col. 6, line 1 – col. 7, line 64; and col. 15, lines 10 – 55).

10. As to claims 8 and 17, Barber-Coley teach a system and method wherein the requesting client computer programmed for enabling a user to select the license server from which to request a commuter authorization (Coley, col. 4, line 1 – col. 5, line 30 and col. 8, line 54 – col. 9, line 61).

11. As to claims 9 and 18, Barber-Coley teach a system and method wherein the at least one license server comprising a pool of license servers, and the granting license server further

programmed for communicating the commuter authorization lifetime and the check-in value stored in the granting license server to other license servers in the pool when the granting license server grants the commuter authorization to the requesting client computer, so that even if the granting license server should go down, another license server in the pool can act as the granting license server Coley, col. 4, line 1 – col. 5, line 30 and col. 8, line 54 – col. 9, line 61).

12. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber-Coley as applied above, and further in view of Schneier et al., US Pat. No. 5,970,143.

13. As to claims 10 and 19, Barber-Coley teach a system and method substantially as claimed. However, Barber-Coley do not explicitly teach a system and method wherein the requesting client computer further programmed for detecting attempts to tamper with its internal clock and invalidating the commuter authorization if tampering is detected.

In the same field of endeavor, Schneier teaches a communication system comprising a tamper alarm system for indicating tampering with the internal clock of the system (Schneier, col. 12, line 45 – col. 13, line 17 and col. 20, line 66 – col. 21, line 23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the tamper indicator as taught by Schneier, into the software licensing system of Barber-Coley for the purpose of increasing system security.

Response to Arguments

14. The applicant argued in substance that:

a. in the prior art of record, specifically in Coley, "the client component communicates with an agent at the license server, not directly with the license server as recited in amended claims 1 and 11." Response, page 13.

As to point a, the distinction the applicant makes is not clear. Communicating with a process executed by an agent on a server is in effect communicating with the server. A server performs many processes in response to client requests. Each of these processes are performed by agents, i.e. programming objects, on the server. Therefore, an action executed by a server agent is the same as that of the server itself.

b. In the claimed invention, "the commuter authorization works independently of the license server once the authorization has been issued, irrespective of whether the client cmputer is connected to the network. In Coley et al., when the client reconnects to the network, the client establishes communication with the agent module in the license server to refresh information in its cache and to supply audit data. In addition, if the client has been disconnected to the network for an extend3ed period of time, the client is prompted to connect to the network (Coley et al., column 22, lines 18-27)." Response, page 13.

In response to point b, the process of reconnecting argued by the applicant is part of the process to re-performing a license validity check. The prior art system, like the

claimed invention, downloads license information and uses this information by setting a timer for authorized use. This process is performed without further connections to the server after the initial license information is obtained. Beyond this teaching, the prior art system teaches revalidating the license information, for instance after the timer has run out, to revalidate the user. However, this teaching is beyond the scope of the claimed invention.

c. McCurdy et al. reference is nonanalogous art and, thus, inappropriate for an obviousness rejection.

In response to point c, a new grounds of rejection set forth in this Office action renders this argument moot.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. After October 26, 2004, all calls should be placed to (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PAUL H. KANG
PRIMARY PATENT EXAMINER